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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,170	02/01/2000	Jeffrey Delaney	109140-0001	5831

7590 05/21/2003

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/496,170

Applicant(s)

DELANEY ET AL.

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment A, 2/27/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-47 and 49-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16, 18-23, 29-42, 48-53 and 59-62 is/are rejected.
- 7) ☒ Claim(s) 12-15, 24-28, 43-46 and 54-58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FINAL DETAILED ACTION

Allowable Subject Matter

1. Claims 12-15, 24-28, 43-46, 54-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4-9, 33-34 and 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by **Pepe et al.** (US 5,742,905).

As to Claims 1, 5, 7, 37-38, with respect to Figures 1-5, **Pepe** teaches a messaging system comprising:

a message server, 48, comprising a plurality of media (modalities) for transmitting messages (Figure 5 and Col. 5, lines 62-64);

a call processor and messaging peripheral (an interface) for receiving a message and a designation of at least some of the transmission modalities (Figure 5, labels 49, 112);

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a PCI database and cache (memory) for storing message delivery (escalation) rules specifying sequential transmission of the message by means of each of the designated media (modalities) upon occurrence of a profile information parameters (specified condition) prior to a recipient's receipt of the message (Col. 23, lines 45-49, Col. 25, lines 26-35 and Col. 26, lines 54-65), and

a routing facility, responsive to the escalation rules and to the occurrence of the conditions, for causing the message to be sequentially transmitted by the message server in accordance with the escalation rules directly to a recipient's personal message receiving device (Col. 31, lines 22-32).

As to Claims 2,4,34,36, **Pepe** teaches the system of claim 1 wherein the condition associated with at least some of the modalities is non-receipt of the message transmitted via said modalities (Col. 28, lines 1-5).

As to Claim 6, **Pepe** teaches the system of claim 1 wherein the interface comprises means for receiving escalation rules from a message sender (Col. 23, lines 45-49).

As to Claims 8,39, **Pepe** teaches the system of claim 1 further comprising:

a. means facilitating response to a received message, the message server receiving the responses; and

b. a memory for collecting records of the responses, the interface being configured to tabulate and present the records in a summary format (Figure 31).

As to Claims 9,40, **Pepe** teaches the system of claim 1 wherein the interface is further configured to receive, from a message sender, a list of recipients for the message and escalation rules for each recipient, the routing facility causing the message to be transmitted to each recipient by the message server in accordance with the escalation rules (Col. 23, lines 39-49).

As to Claim 33, with respect to Figures 1-5, **Pepe** teaches a method of transmitting messages, the method comprising the steps of:

receiving a message and a designation of at least some of a plurality of transmission media (modalities) (Figure 5 and Col. 5, lines 62-64);

storing message delivery (escalation) rules specifying sequential transmission of the message, prior to a recipient's receipt of the message, by means of each of the designated media (modalities) upon occurrence of profile information parameters (a specified condition) (Col. 23, lines 45-49, Col. 25, lines 26-35 and Col. 26, lines 54-65); and

causing the message to be sequentially transmitted in accordance with the escalation rules directly to the recipient via the recipient's personal message receiving device (Col. 31, lines 22-32).

4. Claims 30-32 and 60-62 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Brown et al.** (US 4,972,461).

As to Claims 30,60, with respect to Figures 1-6, **Brown** teaches a messaging system comprising:

a CDS (message server) comprising a plurality of communication modalities for transmitting messages, the modalities including telephony, the message server comprising a telephony server (Figure 1, Col. 4, lines 37-45 and Col. 15, lines 62-67);

an interface for receiving a message and a designation of at least one of the communication modalities (Figure 1, label 131 and Col. 4, lines 61-65, Col. 5, lines 13-22);

a routing facility, responsive to the designation, for causing transmission of the message by means of the designated modalities (Col. 12, lines 38-51); wherein

the telephony server is configured to discriminate between individuals and telephone-answering devices, and to detect receipt of the message by an individual (Col. 15, line 65 through Col. 16, line 6).

As to Claims 31,61, **Brown** teaches the system of claim 30 wherein the interface is configured to report receipt of the message by an individual (Col. 15, lines 10-23).

As to Claims 32,62, **Brown** teaches the system of claim 30 wherein the telephony server is configured to append to the message, upon detection of a telephone-answering device, instructions for subsequently establishing a telephone connection to the telephony server to confirm receipt of the message (Col. 15, lines 24-32, 50-61 and Col. 16, lines 1-6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16,18-22, 47 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe** in view of **Brown et al.** (US 4,972,461).

As to Claims 16,18,19-22,47,49-52, with respect to Figures 1-5, **Pepe** teaches a messaging system comprising:

a message server, 48, comprising a plurality of media (modalities) for transmitting messages (Figure 5 and Col. 5, lines 62-64);

call processor and message peripheral (an interface) for receiving a message and a designation of at least one of the transmission modalities (Figure 5, labels 49,112) ;

PCI database and Cache (a memory) for storing criteria governing use of the at least one designated modality (Col. 23, lines 45-49, Col. 25, lines 26-35 and Col. 26, lines 54-65); and

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a routing facility, responsive to the scheduling criteria, for causing transmission of the message by means of the at least one designated modality in accordance with the criteria (Col. 31, lines 22-32);

wherein the criteria include at least one of (a) blackout periods during which the at least one designated modality may not be used and (b) time windows during which the at least one designated modality may be used, the routing facility causing transmission to occur at a time consistent with the criteria (Col. 23, lines 56-58);

Pepe does not teach the following limitation:

“scheduling criteria”

However, it is obvious that **Pepe** can be modified to accommodate the limitation. This is because **Pepe** teaches directing delivery based on selected time parameters (Col. 23, lines 56-58). **Brown** teaches a customized schedule for delivering messages to recipients (Figure 3, label 312). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add scheduling capability to **Pepe's** invention delivering messages as taught by **Brown's** invention in order to provide user control of message delivery.

8. Claims 3,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe** in view of **Tran** (US 6,202,060).

As to Claims 3,35, **Pepe** teaches the system of claim 1 wherein the modalities comprise electronic mail, facsimile transmission, public telephone network, cellular telephone, pager;

Pepe does not teach the following limitations:

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“postal mail”

However, it is obvious that **Pepe** can be modified to accommodate the limitation. This is because **Pepe** teaches message integration, routing and delivery (Col. 23, lines 13-22). **Tran** teaches the limitation (Col. 7, lines 53-63 and Col. 37, lines 37-40). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add postal mail capability to **Pepe**'s invention for delivering messages as taught by **Tran**'s invention in order to provide delivery of messages using different media.

9. Claims 10-11, 13-14 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe**.

As to Claims 10-11,13-14, 41-42, **Pepe** teaches the system of claim 1 wherein the interface is further configured to receive, from a message sender, a list of potential message recipients and criteria associated with each potential recipient, the interface facilitating searching of the list based on specified criteria and identification of potential recipients whose recipient criteria match the specified criteria (Col. 23, lines 39-49);

Pepe does not teach the following limitation:

“global list”

However, it is obvious that **Pepe** can be modified to accommodate the limitation. This is because **Pepe** teaches distribution lists for recipients over networks which include the Internet (Figures 1-5 and Col. 1, lines 36-42). Having the cited art at the time the invention was made, it

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would have been obvious to one of ordinary skill in the art to add global list capability to **Pepe's** invention in order to provide message delivery to global users anywhere and at anytime.

10. Claims 23,29,53 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe** in view of **Brown et al.**

As to Claims 23,29,53,59, **Pepe** teaches the messaging system of claim 16 wherein:

the interface also receives (ii) a plurality of recipients, and (iii) for each recipient, a designation of at least one of the communication modalities (Col. 23, lines 39-49);

and wherein the routing facility, responsive to the designation, transmits the message by means of the designated modalities (Col. 23, lines 29-49), wherein

the interface is configured to present a tabulated version of the responses (Figure 31)

Pepe does not teach the following limitations:

“a message inviting a response” and “the communication modalities are configured to remotely receive the responses from the recipients”

However, it is obvious that **Pepe** can be modified to accommodate the limitations. This is because **Pepe** teaches distribution lists for recipients over networks which include the Internet (Figures 1-5 and Col. 1, lines 36-42). Brown teaches reply response messages and remote recipients (Figure 1 and Figure 2, label 209). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reply capability to **Pepe's** invention for obtaining replies to messages as taught by Brown's invention in order to provide message delivery status responses from users anywhere and at anytime.

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Response to Arguments

11. Applicant's arguments with respect to claims 1-16, 18-47 and 49-62 have been considered but are moot in view of the new ground(s) of rejection and the following:

With respect to Claims 30,60, **Brown** does not teach discriminating because the invention can use escalation rules to send another message.

Examiner respectfully disagrees because the argument is not directed towards the claims which do not recite sending another message. **Brown** does teach the claimed discrimination because it determines whether a recipient or an answering machine has answered a call.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cox et al. (US 6,396,920) teach message delivery using schedules to recipients and answering machines.

Bartholomew et al. (US 6,215,858) teach message delivery using selective format conversions.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

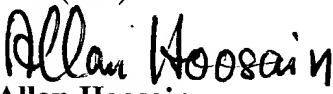
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
5/15/03